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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,550	04/02/2004	Jeremy Alan Ortega	7400	2527

7590 09/05/2007
Robert D. Touslee
Johns Manville International, Inc.
10100 West Ute Avenue
Littleton, CO 80127

EXAMINER

NGUYEN, CHI Q

ART UNIT	PAPER NUMBER
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3635

MAIL DATE	DELIVERY MODE
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09/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/817,550	Applicant(s) ORTEGA, JEREMY ALAN	
	Examiner Chi Q. Nguyen	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,15,16,27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,17-26 and 29-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Attachment</u> . |

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DETAILED ACTION

Applicant's election without traverse of Species I (Fig. 2) in the reply filed on 7/16/2007 is acknowledged.

Status Of Claims

Claims 1, 2, 5-14, 17-26, and 29-36 are pending and have been examined.

Claims 3-4, 15-16, and 27-28 are drawn to non-elected claims.

Claim Objections

Claims 20, 22, 32, and 34 are objected to because of the following informalities: a citation "cutting means comprises an peripheral" should read –cutting means comprises a peripheral--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, and 5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,250,034 to Hulsey.

Claim 1:

Hulsey discloses a roof sheet membrane fastener assembly for securing a roof sheet membrane with a topside release sheet to a roof substrate, comprising: a mechanical

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fastener 68 for passing through a roof sheet membrane with a topside release sheet and into a roof substrate overlaid by the roof sheet membrane to secure the roof sheet membrane to the roof substrate; and a disk 10 through which the mechanical fastener passes for contacting and overlaying a portion of the topside release sheet of the roof sheet membrane that immediately surrounds the mechanical fastener and for causing the portion of the topside release sheet overlaid by the disk to separate from a remainder of the topside release sheet when the topside release sheet is removed from the roof sheet membrane.

Claim 2:

Wherein: the mechanical fastener comprises an topside head portion H (see attached Fig. 3) and a slender shank portion S for passing through the roof sheet membrane and into the roof substrate to secure the roof sheet membrane to the roof substrate; and the slender shank portion of the mechanical fastener is integral with and depends from the topside head portion of the mechanical fastener and passes through the disk (see Fig. 4).

Claim 5:

Wherein: the disk has a peripheral separation means 14 depending from an outer peripheral edge portion of the disk for at least weakening the topside release sheet to facilitate the separation of the portion of the topside release sheet overlaid by the disk from the remainder of the topside release sheet when the topside release sheet is removed from the roof sheet membrane with no or substantially no degradation of the performance of the roof sheet membrane.

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Claim 6:

Wherein: the peripheral separation means comprises peripheral cutting means for at least partially cutting through the topside release sheet (see col. 3, lines 8-11).

Claim 7:

Wherein: the peripheral cutting means comprises a series of teeth (see Figs. 1-2) for penetrating the topside release sheet.

Claim 8:

Wherein: the peripheral cutting means comprises a peripheral cutting edge for penetrating the topside release sheet.

Claim 9:

Wherein: the peripheral cutting means comprises a series of teeth (see Figs. 1-2) for passing through the topside release sheet.

Claim 10:

Wherein: the peripheral cutting means comprises a peripheral cutting edge for passing through the topside release sheet.

Claim 11:

Wherein: the peripheral cutting means of the disk 10 has a depth and the roof sheet membrane fastener assembly is adapted to be used with a roof sheet membrane having a topside release sheet having a thickness greater than the depth of the peripheral cutting means whereby the peripheral cutting means scores the topside release sheet, without passing completely through the topside release sheet, to weaken the release sheet at the peripheral cutting means with no degradation of the performance of the roof

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sheet membrane, and the release sheet is easily separable at the peripheral cutting means when the release sheet is removed from the roof sheet membrane (see Fig. 3).

Note that a roof sheet membrane is not positively claimed.

Claim 12:

Wherein: the peripheral cutting means of the disk 10 has a depth and the roof sheet membrane fastener assembly is adapted to be used with a roof sheet membrane having a topside release sheet having a thickness substantially equal to the depth of the peripheral cutting means whereby the peripheral cutting means severs or substantially severs the topside release sheet at the peripheral cutting means with no or substantially no degradation of the performance of the roof sheet membrane and the release sheet is easily separable at the peripheral cutting means when the release sheet is removed from the roof sheet membrane (see Fig. 3).

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,233,889 to Hulseley.

Claim 13:

Hulseley discloses a roof sheet membrane system, comprising: a roof sheet membrane 16 overlaying a portion of a roof substrate; the roof sheet membrane having a topside major surface that is an adhesive bonding surface and a bottom side major surface that is not adhesively secured to the roof substrate (see col. 1 lines 22-27); the topside major surface being overlaid by a topside release sheet 20; the roof sheet membrane being secured to the roof substrate by a plurality of mechanical fastener assemblies (see Figs. 1-2); each of the mechanical fastener assemblies comprising a mechanical

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fastener 24 passing through the topside release sheet and the roof sheet membrane and into the roof substrate to secure the roof sheet membrane to the roof substrate; and a disk 12 through which the mechanical fastener passes contacting and overlaying a portion of the topside release sheet of the roof sheet membrane that immediately surrounds the mechanical fastener for causing the portion of the topside release sheet overlaid by the disk to be easily separable from a remainder of the topside release sheet when the topside release sheet is removed from the roof sheet membrane.

Claim 14:

Wherein: each of the mechanical fasteners comprises an topside head portion (wherein 24 points to) and a slender shank portion (threaded portion) that passes through the roof sheet membrane and into the roof substrate to secure the roof sheet membrane to the roof substrate; and the slender shank portion of the mechanical fastener is integral with and depends from the topside head portion of the mechanical fastener and passes through the disk (see Figs. 1-2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-26, and 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,233,889 to Hulsey in view of US Patent No. 6,250,034 to Hulsey.

Claims 17-24:

Hulsey '889 discloses the basic structures for a roof membrane assembly as stated but does not disclose wherein: the disk of each of the mechanical fastener assemblies has a peripheral separation means depending from an outer peripheral edge portion of the disk that at least weakens the topside release sheet to facilitate the separation of the portion of the topside release sheet overlaid by the disk from the remainder of the topside release sheet when the topside release sheet is removed from the roof sheet membrane with no or substantially no degradation of the performance of the roof sheet membrane, the peripheral separation means comprises peripheral cutting means that at least partially cuts through the topside release sheet, the peripheral cutting means comprises a series of teeth that penetrate the topside release sheet, the peripheral cutting means comprises a peripheral cutting edge that penetrates the topside release sheet, the peripheral cutting means of the disk has a depth and the topside release sheet of the roof sheet membrane has a thickness substantially equal to the depth of the peripheral cutting means whereby the peripheral cutting means severs or substantially severs the topside release sheet at the peripheral cutting means with no or substantially no degradation of the performance of the roof sheet membrane and the release sheet is easily separable at the peripheral cutting means when the release sheet is removed from the roof sheet membrane. Hulsey '034 discloses a membrane plate 10 having a plurality of cutting means 14, which are a set of teeth (see Figs. 1-2) for cutting or perforating the membrane plate 10 (see col. 3, lines 8-11). In view of Hulsey '034, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to provide Hulsey '889 with a set of teeth function as cutting means for facilitating assembly more securement and preventing pulled out fasteners.

In regard method claims 25-26, and 29-36:

Hulsey '889 in view Hulsey '034 disclose the basic structures for roofing membrane assembly as stated above but do not disclose expressly a method of forming a roof membrane system, examiner considers this to be the obvious method of setting up device because in forming a roof membrane system, one must obviously secure a roof membrane to a roof deck by a plurality of fasteners, each of the fasteners has a plate integrally formed with a plurality teeth functioning as cutting means for anchoring on the roofing membrane, and the roofing membrane having adhesive material on top surface for bonding with the fastener. Both Hulsey prior arts would be motivated to follow these steps to facilitate assembly to make a stronger roofing structure.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at (866) 217-9197.


CQN

8/29/2007

/JEANETTE CHAPMAN/
PRIMARY EXAMINER
ART UNIT 3635

